

First Amendment
U.S. Patent Application Serial No. 09/885,650
Office Action Dated: August 11, 2005
Inventor: Matthew John Bending
Attorney Docket No. 41759-57264

REMARKS

This Amendment is filed in response to the Office Action dated August 11, 2005.

Objections Under 37 C.F.R. Section 1.75(d)(1):

Claims 3, 12 and 13 were objected to under 37 C.F.R. Section 1.75(d)(1) for failing to mention the term "identifying code" recited in these claims in the specification. Claims 3, 12 and 13 are now cancelled and it is respectfully believed that these objections are rendered moot.

Rejections Under 35 U.S.C. Section 112:

Claims 3, 4, 12 and 13 were objected to under 35 U.S.C. Section 112, second paragraph, as being indefinite for particularly pointing out and distinctly claiming the subject matter which the applicant regards as the invention. Claims 3, 4, 12 and 13 are now cancelled and it is respectfully believed that these rejections are rendered moot.

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Rejections Under 35 U.S.C. Section 101:

Claims 1-9 are rejected under 35 U.S.C. Section 101 for not being "within the technological arts." Claim 1 is amended to recite: "...providing an information system which comprises a database **associated with at least one processor**, the database containing stored data upon a plurality of facilities which have space available for advertising and promotional purposes; ." Support for this amendment can be found on Page 3, Lines 5-7, of the Applicant's specification which recites: "The CPU may be a single commercially available processor or else may be a number of such processors operating in parallel." Therefore, no new matter will be added. A processor fully comports with the outstanding Examiner's suggestion as being the embodiment of a nontrivial computer limitation.

Claims 2-9 were also rejected under 35 U.S.C. Section 101. Claims 3-5 are hereby cancelled and it is respectfully believed that this rejection with respect to Claims 3-5 is rendered moot. Since Claims 2 and 6-9 depend from and contain all of the limitations of Claim 1, as amended, Claims 2 and 6-9 overcome the rejection under 35 U.S.C. Section 101 in the same manner as Claim 1.

Therefore, Claims 1, 2, 6-9 overcome the rejection under 35 U.S.C. Section 101.

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Rejections Under 35 U.S.C. Section 102(e):

Claims 1 and 10 were rejected under 35 U.S.C. Section 102(e) as being unpatentable over Eller (U.S. Patent Publication No. 2002/0116717). Claims 1 and 10 are amended to recite: "...**providing a search engine on the system, the search engine adapted to search the stored data in response to search parameters inputted by the user....**" Support for this amendment can be found in Paragraph [0015], Lines 1-8 or Page 4, Lines 15-20, which recites: "The website can also offer a fully interactive search facility whereby customers may input particular requirements for the advertising space that they require in a particular geographical area (e.g. footfall, size of retail space, pricing, etc.) and **the search engine** will list suitable malls in that area. This provides a quick alternative to the client browsing through the different pages for each mall, as at step 1 of FIG. 1." Also, Claim 5, which is now cancelled, previously recited: "...further comprising the step of providing a **search capability** on the system so that a user may **search for facilities whose data matches the requirements of that user.**" Therefore, no new matter has been added.

In marked contrast, Eller only recites in Paragraph [0025], Sentences 2-5: "In step 302, the client may view a map of the United States, any other country, or even the entire world with indications where the billboard provider's electronic billboards are

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located. **Using a zoom feature, the client may zoom in on a particular location, such as New York City, to pinpoint the location of the electronic billboard, down to the precise city block.** Furthermore, the client may view a photo of the billboard showing the billboard height, width, the direction the billboard is facing, etc.

Alternatively, even an image of an indoor billboard can be displayed to the client."

Therefore, Eller involves visually zooming in and out of billboard locations on visual maps and not searching for facilities based on user requirements. Therefore, the utilization of a search engine to search for facilities that meet the user's requirements is a unique feature that provides a significant advantage that does not appear in Eller.

It is now a basic tenet of patent law that the results and advantages produced by the claimed subject matter, of which the prior art is devoid, cannot be ignored simply because the claim limitations are similar to the otherwise barren prior art. It is respectfully believed that the patentability of the claimed subject matter must be determined in view of the invention "as a whole." Moreover, for a valid 35 U.S.C. Section 102(e) rejection, it is respectfully believed that a single reference must teach each and every element of the rejected claim. In this case, a search engine to search for facilities that meet the user's requirements is a completely missing element that provides significant advantages over the **visual map zooming feature** disclosed in Eller.

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Moreover, a proper application of a reference against a device described and claimed in a patent application requires broadly that the anticipatory device be substantially the same as the anticipated device in structure, function and result. In this case, and at the very least, the map zooming feature of Eller does not provide a search engine so that a user may search for facilities whose data matches the requirements of that user. Therefore, there is a very different structure, function and result.

In addition, it is respectfully believed that the United States Patent Office is not permitted to ignore the results and advantages of the claimed subject matter, of which the prior art is devoid, simply because the claim limitations are similar to the otherwise barren prior art. The search engine of the present invention allows the user to locate suitable advertising space in a facility without having to do a geographical browse through all the billboard locations as is required by Eller.

In addition, hindsight is not the test of anticipation nor is it alone sufficient that other known websites may have been adapted without too much difficulty to produce the object and function of the Applicant's Invention, as claimed. There is no motivation to modify Eller since Eller was only concerned with viewing the location on a visual map.

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Therefore, Claims 1 and 10 overcome the rejection under 35 U.S.C. Section 102(e).

Claims 2, 5, 7, 8, 11, 15 and 16 were also rejected under 35 U.S.C. Section 102(e). Claim 5 is hereby cancelled and it is respectfully believed that this rejection with respect to Claim 5 is rendered moot. Since Claims 2, 7, 8, 11, 15 and 16 depend from and contain all of the limitations of Claims 1 and 10, as amended, Claims 2, 7, 8, 11, 15 and 16 are felt to distinguish over Eller in the same manner as Claims 1 and 10.

Therefore, Claims 1, 2, 5, 7, 8, 10, 11, 15 and 16 overcome the rejection under 35 U.S.C. Section 102(e) as being anticipated by Eller.

Rejections Under 35 U.S.C. Section 103(a):

Claims 3, 4, 9, 12-14 and 19 were rejected under 35 U.S.C. Section 103(a) as being unpatentable over Eller. Since Claims 3, 4, 12-14 are hereby cancelled, it is respectfully believed that the rejection with regard to these claims is rendered moot.

Claims 9 and 19 recite that the facilities are shopping malls. Claim 9 depends from Claim 1, as amended, and Claim 19 depends from Claim 10, as amended, and contains each and every limitation thereof of the associated independent claim. If an independent claim is nonobvious under 35 U.S.C. Section 103, then any claim depending therefrom is nonobvious. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596

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(Fed. Cir. 1988). As described previously above, Claims 1 and 10 are clearly patentable over Eller.

It was explicitly held in In re Sang Sung Lee, 61 U.S.P.Q.2d 1430 (C.A.F.C. 2002) that: "Rejection of patent application for obviousness under 35 U.S.C. Section 103 must be based on evidence comprehended by language of that section, and search for and analysis of prior art includes evidence relevant to finding of whether there is teaching, motivation, or suggestion to select and combine references relied on as evidence of obviousness; **factual inquiry whether to combine references must be thorough and searching, based on objective evidence of record, and Board of Patent Appeals and Interferences must explain reasons why one of ordinary skill in art would have been motivated to select references and to combine them to render claimed invention obvious.**" In this case, there is no objective evidence of record that would lead an individual of ordinary skill in the art to modify a facility to make it a shopping mall, as the entity having a bookable advertising space, without any hint or suggestion in the prior art for doing so.

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art.

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"The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." In re Kotzab, 217 F.3d 1365, 1370, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000); In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); and In re Jones, 958 F.2d 347, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992).

In this case, there is no teaching, hint or suggestion provided by the Examiner to provide a search engine on the system of Eller, the search engine adapted to search the stored data in response to search parameters inputted by the user and then to convert a facility that has bookable advertising space into a shopping mall. **It is well established in U.S. Patent Law as well as the Manual for Patent Examining Procedure (M.P.E.P.) Section 2143.03 that to establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970).**

Therefore, Claims 3, 4, 9, 12-14 and 19 overcome the rejection under 35 U.S.C. Section 103(a) as being unpatentable over Eller.

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Claims 6 and 8 are rejected under 35 U.S.C. Section 103(a) as being unpatentable over Eller in view of Unold (U.S. Patent Application No. 2002/0055880).

Claim 6 depends from Claim 1, as amended, and Claim 18 depends from Claim 10, as amended, and contains each and every limitation thereof of the associated independent claim. If an independent claim is nonobvious under 35 U.S.C. Section 103, then any claim depending therefrom is nonobvious. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). As described previously above, Claims 1 and 10 are clearly patentable over Eller.

Moreover, it is respectfully believed that it is improper to apply an "obviousness to try" standard or indulge in hindsight evaluation or reconstruction. See Ecolchem, Inc. v. Southern California Edison Co., 56 U.S.P.Q. 1065 (Fed. Cir. 2000). In this case, neither cited reference discloses the use of a search engine for providing a **search capability** on the system so that a user may **search for facilities whose data matches the requirements of that user and it is axiomatic that when this feature is not disclosed in either reference that the combinations of these references cannot result in the claimed invention.**

Therefore, Claims 6 and 18 overcome the rejection under 35 U.S.C. Section 103(a) as being unpatentable over Eller in view of Unold.

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Claim 17 is rejected under 35 U.S.C. Section 103(a) as being unpatentable over Eller in view of Thomson (U.S. Patent Application No. 2003/0061104).

Claim 17 depends from Claim 10, as amended, and contains each and every limitation thereof of the associated independent claim. If an independent claim is nonobvious under 35 U.S.C. Section 103, then any claim depending therefrom is nonobvious. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). As described previously above, Claim 10 is clearly patentable over Eller.

Moreover, although Thompson teaches a call center, it does not provide the slightest hint or suggestion as to why this feature should be combined with an advertising booking invention. "In determining the propriety of the Patent Office case for obviousness in the first instance, it is necessary to ascertain whether or not the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the reference before him to make the proposed substitution, combination, or other modification." In re Linter, 458 F.2d 1013, 1016, 173 U.S.P.Q. 560, 562 (C.C.P.A. 1972). There is nothing disclosed regarding why a call center should be combined with a reference regarding the booking of advertising and not the slightest hint or suggestion as to why this claimed feature should be created. Moreover neither cited reference discloses the use of a search engine for providing a **search capability** on the system so that a user may **search for facilities whose data matches**

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the requirements of that user and it is axiomatic that when this feature is not disclosed in either reference that the combinations of these two references cannot result in the claimed invention.

Therefore, Claim 17 overcomes the rejection under 35 U.S.C. Section 103(a) as being unpatentable over Eller in view of Thomson and is in condition for allowance.

Therefore, it is now believed that all of the pending Claims in the present application are in condition for allowance. Favorable action and allowance of the Claims is therefore respectfully requested. If any issue regarding allowability of any of the pending Claims in the present application could be readily resolved, or if other action could be taken to further advance this application such as an Examiner's Amendment, or if the Examiner should have any questions regarding the present Amendment, it is respectfully requested that the Examiner please telephone the Applicant's undersigned attorney in this regard.

Respectfully submitted,

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